

GENERALLY

Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. “The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.”¹ During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification,”² and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.³ Therefore, the Office must (i) identify the individual elements of the claims and properly construe these individual elements,⁴ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁵

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.⁶ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁷

The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁸

¹ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

² In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

³ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁴ Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, “what is the invention claimed?” since “[c]laim interpretation, . . . will normally control the remainder of the decisional process”); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁵ Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁶ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).

⁷ In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990).

⁸ In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

REMARKS

Claims 1-5 and 7-11 are pending in the application.

Claims 1-3, 5 and 7 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0115137 A1 (hereinafter “*ROWE*”) in view of U.S. Patent Publication No. 2003/0097331 A1 (hereinafter “*COHEN*”).

Claims 4 and 9-10 stand rejected under 35 USC § 103(a) as being unpatentable over *ROWE* in view of *COHEN*, and further in view of U.S. Patent Publication No. 2001/0047310 A1 (hereinafter “*RUSSELL*”).

Claim 8 stands rejected under 35 USC § 103(a) as being unpatentable over *ROWE* in view of *COHEN* and *RUSSELL*, and further in view of U.S. Patent Publication No. 2003/0119478 A1 (hereinafter “*NAGY*”).

Regarding Response to Arguments

The undersigned renews an argument made in the Reply of 12/19/2008 that the Office has yet to articulate reasoning with some rational underpinning (as required by statute, MPEP, and case law⁹) for combining the references for each rejection under 35 USC § 103 (a). The OA merely misstates outdated case law in asserting that that teaching, suggestion, or motivation for combining references is the only way to establish obviousness. Even if the “teaching, suggestion, or motivation” test was the appropriate measure of obviousness, neither the OA nor any prior Office Communications applies the test.

The OA does not articulate reasoning with rational underpinning to support the legal conclusion of obviousness. For at least this reason, the OA does not state a *prima facie* case of unpatentability under 35 USC § 103(a), and the undersigned requests that the rejection of the Claims 1-5 and 7-11 be withdrawn.

Rejection of Claims 1-3, 5, and 7 as Unpatentable Over *ROWE* in View of *COHEN*

For at least the reasons presented above in *Regarding Response to Arguments*, the OA does not state a *prima facie* case of unpatentability with respect to Claims 1-3, 5, and 7. For at

⁹ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

least these reasons, the undersigned requests the rejection of Claims 1-3, 5 and 7-11 be withdrawn.

With regard to Claim 5, the OA asserts that COHEN teaches programming the service provider computer “to permit the user to authorize the sub-account to establish further sub-account subordinate to the sub-account” at COHEN P202.

COHEN P202 discloses:

As another example, a parent could give a teenage child a card to go out and make a specific purchase for the child or for the parent. The card could be valid only for purchase on that particular day, to a certain designated purchase limit, and even, if desired only in a certain store, or group of stores or types of stores (e.g. clothing stores), or types of purchases or items. The main account could have, for example, a \$1500 credit card limit, but the parent could set a \$100 limit for use of the customized card on that particular day. Thus, if the card is lost or stolen, the card can not be used at stores other than the types chosen by the parent. Use in any other type of store or on any day other than that one day will cause the card to be declined. This minimizes the amount of credit card loss which can occur, and increases the chances of catching the thief. Likewise, the sublimit of \$100 also minimizes the amount of loss which is possible.

The cited section of COHEN discloses limits on the child's sub-account, where the child's sub-account is subordinate only to the parent's primary account. COHEN clearly does not disclose permitting the parent to **authorize the child to establish a further sub-account subordinate to the child's sub-account**. In fact, the undersigned could not find any disclosure in the references of record directed to authorizing a sub-account holder to create accounts subordinate to that holder's sub-account. Absent such disclosure, the OA does not state a *prima facie* case of unpatentability for this claim. Consequently, the undersigned request that this rejection be withdrawn.

Rejection of Claims 4 and 9-10 as Unpatentable Over ROWE in View of COHEN and RUSSELL

For at least the reasons presented above in *Regarding Response to Arguments*, the OA does not state a *prima facie* case of unpatentability with respect to Claims 4 and 9-10. For at least these reasons, the undersigned requests the rejection of Claims 4 and 9-10 be withdrawn.

With regard to Claim 9, the OA asserts that RUSSELL teaches “*periodically sending notifications to the primary account user that list all transactions of the sub-account at*” at RUSSELL P30 and P56.

RUSSELL P30 discloses in relevant part:

As a management function of the controller, the software periodically checks the parent/child account and reviews balances to determine if the account balance is low. If so, the software generates an electronic or paper message to the parent notifying him that it is time to replenish the account.

RUSSELL P56 discloses in relevant part:

The transaction database 265 will contain a record of all monetary transactions recorded through the central controller/trustee 200 including child account number, selling institution/vendor number, item purchased, amount of purchase, date and timestamp of purchase.

The cited sections of RUSSELL separately disclose “time to replenish the account” messages based on conditions determined from periodic checks, and a database containing transaction information, but **clearly do not disclose that messages that list all transactions are periodically sent to the primary account user.** Absent such disclosure, the OA does not state a *prima facie* case of unpatentability for this claim. Consequently, the undersigned request that this rejection be withdrawn.

Rejection of Claim 8 as Unpatentable Over ROWE in View of COHEN, RUSSELL, and NAGY

For at least the reasons presented above with regard to Response to Arguments, the OA does not state a *prima facie* case of unpatentability with respect to Claim 8. For at least these reasons, the undersigned requests the rejection of Claim 8 be withdrawn.

With regard to Claim 8, the OA asserts that NAGY teaches “*permit the user to add funds to the sub-account during a transaction*” at RUSSELL P63-63.

The language of NAGY 61-63 uses the word “transaction” to describe the function of adding funds to an account, e.g. (**bold emphasis added**):.

[0061] FIG. 6 is a schematic diagram that provides further detail regarding the wireless telecommunications payments

system objects shown in FIG. 1 and an example of the flow of information between the system objects in **the subscriber initiated replenishment transaction process** for an embodiment of the present invention. ...

This use is contrary to the use or “transaction” in the present application. In Claim 8, the “transaction” is what takes place between a vendor and the user. The subject of the Claim 8 “transaction” is the purchase of some good/service from a party (i.e., a vendor) other than the service provider. The service provider (akin to Nagy’s “mobile operator”) facilitates transactions between vendors and users. The function of “add funds” in Claim 8 is not a “transaction” that takes place between the user and a vendor.

The references do not disclose permitting the user to add funds to a sub-account “during a transaction.” Absent such disclosure, the OA does not state a *prima facie* case of unpatentability for this claim. Consequently, the undersigned request that this rejection be withdrawn.

Rejection of Claim 8 as Unpatentable Over ROWE in View of COHEN, RUSSELL, and NAGY

For at least the reasons presented above in *Regarding Response to Arguments*, the OA does not state a *prima facie* case of unpatentability with respect to Claim 8. For at least these reasons, the undersigned requests the rejection of Claim 8 be withdrawn.

With regard to Claim 8, the OA asserts that NAGY teaches “*permit the user to add funds to the sub-account during a transaction*” at RUSSELL P63-63.

The language of NAGY 61-63 uses the word “transaction” to describe the function of adding funds to an account, e.g. (**bold emphasis added**):

[0061] FIG. 6 is a schematic diagram that provides further detail regarding the wireless telecommunications payments system objects shown in FIG. 1 and an example of the flow of information between the system objects in **the subscriber initiated replenishment transaction process** for an embodiment of the present invention. ...

This use is contrary to the use or “transaction” in the present application. In Claim 8, the “transaction” is what takes place between a vendor and the user. The subject of the Claim 8 “transaction” is the purchase of some good/service from a party (i.e., a vendor) other than the service provider. The service provider (akin to Nagy’s “mobile operator”) facilitates transactions

between vendors and users. The function of “add funds” in Claim 8 is not a “transaction” that takes place between the user and a vendor.

The references do not disclose permitting the user to add funds to a sub-account “during a transaction.” Absent such disclosure, the OA does not state a *prima facie* case of unpatentability for this claim. Consequently, the undersigned request that this rejection be withdrawn.

Rejection of Claim 11 as Unpatentable Over ROWE in View of COHEN, RUSSELL, and Official Notice

For at least the reasons presented above in *Regarding Response to Arguments*, the OA does not state a *prima facie* case of unpatentability with respect to Claim 11. For at least these reasons, the undersigned requests the rejection of Claim 11 be withdrawn.

The OA asserts that RUSSELL teaches, at RUSSELL Fig. 11 and RUSSELL [0028], a computer:

... programmed to send a notification to the user of the primary account, the notification including a link that the user may activate to lock the sub-account.

The OA asserts, at OA P08, that RUSSELL teaches this through teaching:

... sending notification the user of primary account regarding an upcoming event, and the primary account user has option to fund the event directly through the service provider computer (Fig. 11); the primary account user also has option to disallow the sub-account user to make any purchase (§ 28).

The OA, at OA P08, relies on Official Notice that:

It is well known in the art that notification has a link.

This rejection should be withdrawn for several reasons.

First, assuming that Official Notice is properly taken and properly combined with the references, the references and Official Notice are insufficient to establish a *prima facie* case of unpatentability because the officially-noticed fact must be asserted to be capable of instant and unquestionable demonstration as being well-known **prior to conception of the invention by the inventor**. Here, the assertion that it “**is well known**” is insufficient to establish that it was well known prior to conception of the invention by the inventor.

Second, the Official Notice is improperly taken because OA does not provide specific factual findings predicated on sound technical and scientific reasoning as required for taking of Official Notice.¹⁰ The OA merely asserts Official Notice. Without such reasoning, it is difficult for the applicant to adequately traverse the rejection.¹¹ On this basis, it is neither necessary, nor possible for the Official Notice to be traverse in the fashion called for by MPEP § 2144.03 C.¹²

Third, the Official Notice is improperly taken, and the undersigned demands documentary evidence that links (conceded to be well known prior to conception of the invention by the inventor for the purpose of navigating between HTML pages) in a notification were known prior to conception of the claimed invention by the inventor.

Fourth, assuming that Official Notice was properly taken, the combination of Official Notice with RUSSELL is insufficient to render the limitation introduced in Claim 11 unpatentable. Claim 11 calls for the activation of the link to perform an action other than simple navigation (the purpose of the Officially-Noticed link), i.e., lock the sub-account. While RUSSELL [0028] discloses "... parental controls or restrictions that may prevent the child from making the purchase ...", and Official Notice is taken that a notification has a link, neither the references nor Official Notice account for the link to perform a function other than navigation, e.g., between HTML pages.

Fifth, the patentability of independent Claim 1, on which Claim 11 depends, renders Claim 11 patentable.

For at least these reasons, the undersigned requests that this rejection be withdrawn.

¹⁰ In re Soli, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963).

¹¹ See MPEP §2144.03 B.

¹² Further, the procedure called for by MPEP § 2144.03 constitutes improper burden shifting. It is the Office's burden to state a *prima facie* case of unpatentability. That burden cannot be met by the mere incantation of a magic words "Official Notice" along with some reasoning. Such an approach is not a substitute for producing references.

CONCLUSION

The foregoing is submitted as a full and complete response to the OA mailed 02/13/2009. With consideration of the above remarks, the undersigned submits that this application is in condition for allowance, and such disposition is earnestly solicited.

The OA contains characterizations of the claims and the references with which the Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the OA. In discussing the specification, claims, and drawings in this Reply, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted to the maximum extent permitted by statute, regulation, and applicable case law.

The undersigned requests: 1) an in-person interview at the Examiner's earliest convenience to identify and resolve any issues impeding examination of the application, and 2) a non-final Office Action applying references to the claim language.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 14-1437 and please credit any excess fees to such deposit account.

Respectfully submitted,

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